

This Opinion is Not a
Precedent of the TTAB

Mailed: November 22, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Kona USA, Inc.

v.

Global Esprit Inc.
—

Opposition No. 91244876
—

Sheila Fox Morrison, Steven E. Klein, and Amanda Linn of Davis Wright Tremaine
LLP for Kona USA, Inc.

John R. Schaefer of Bacon & Thomas, PLLC for Global Esprit Inc.
—

Before Bergsman, Goodman, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Global Esprit Inc. (“Applicant”) seeks registration on the Principal Register of the
mark shown below

The logo consists of the word "KONA" in a bold, stylized, hand-drawn font, followed by the number "81" in a similar style. The letters are thick and black, with some irregular edges, giving it a graphic, artistic appearance.

for goods identified as follows:

Bath sandals; Bath slippers; Bathing suits for men; Bathing caps; Bathing costumes; Bathing suits; Bathing trunks; Beach footwear; Beach shoes; Dry suits; Fitted swimming costumes with bra cups; Leather shoes; Parts of clothing, namely, gussets for tights, gussets for stockings, gussets for bathing suits, gussets for underwear, gussets for leotards and gussets for footlets; Protective neck and arm guards made of neoprene or other materials to prevent wetsuit chafing; Rash guards; Rash vests; Sandals and beach shoes; Skating outfits; Ski suits for competition; Ski wear; Skiing shoes; Skirt suits; Snow boarding suits; Sport coats; Sport shirts; Sports caps and hats; Sports jerseys and breeches for sports; Sports jackets; Sports pants; Sports vests; Surf wear; Swim wear; Swim wear for gentlemen and ladies; Swimming caps; Travel clothing contained in a package comprising reversible jackets, pants, skirts, tops and a belt or scarf; Triathlon clothing, namely, triathlon tights, triathlon shorts, triathlon singlets, triathlon suits; Vested suits; Waterproof footwear; Waterproof jackets and pants; Waterproof leather shoes and boots; Wet suit gloves; Wet suits for water-skiing and sub-aqua; Bottoms as clothing; Pullovers; Shirts; Swimsuits, in International Class 25.¹

Kona USA, Inc. (“Opposer”) opposes registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles Opposer’s standard character mark KONA, registered on the Principal Register for “bicycles,” and Opposer’s pleaded common law mark KONA for

¹ Application Serial No. 87934992 was filed on May 24, 2018 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce. As originally filed, the application also included goods identified as “Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms;” “Clothing for athletic use, namely, padded pants;” “Clothing for athletic use, namely, padded shirts;” “Clothing for athletic use, namely, padded shorts;” “Cyclists’ jerseys;” and “Triathlon shirts.” As explained below, the opposition was sustained as to these goods prior to trial, and they are no longer in the application.

apparel, as to be likely, when used on or in connection with the remaining goods identified in the application, to cause confusion, to cause mistake, or to deceive.²

The case is fully briefed.³ We sustain the opposition as to all of the goods remaining in the application.

I. Record and Evidentiary Issues

The record consists of the pleadings,⁴ the file history of the opposed application, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the testimony declaration of Jacob Heilbron, Opposer's co-founder, and Exhibits 1-44 thereto ("Heilbron Decl."), 29 TTABVUE 2-344;⁵ Opposer's First Notice of Reliance and

² In its First Amended Notice of Opposition, Opposer also asserted a claim that Applicant lacked a bona fide intention to use the mark in commerce in connection with the goods originally identified in the application as "Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms;" "Clothing for athletic use, namely, padded pants;" "Clothing for athletic use, namely, padded shirts;" "Clothing for athletic use, namely, padded shorts;" "Cyclists' jerseys;" and "Triathlon shirts." 23 TTABVUE 11-13. Opposer moved for partial summary judgment on that claim, 24 TTABVUE, and the Board granted the motion as conceded, sustaining the opposition "as to those goods, only" and stating that the opposition would "move forward on Opposer's claim of likelihood of confusion with respect to the remaining goods in the involved application." 27 TTABVUE 2.

³ Citations in this opinion to the briefs refer to TTABVUE, the Board's online docketing system. *Turdin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Opposer designated portions of its main brief as Confidential Attorney's Eyes Only under the Board's Standard Protective Order. Opposer's unredacted main brief appears at 34 TTABVUE and its reply brief appears at 38 TTABVUE. Applicant's brief appears at 36 TTABVUE.

⁴ The operative pleadings are Opposer's First Amended Notice of Opposition, 23 TTABVUE 7-13, and Applicant's Answer to Opposer's First Amended Notice of Opposition. 26 TTABVUE 2-8. In its Answer, Applicant denied the salient allegations in Opposer's First Amended Notice of Opposition, and asserted two "Affirmative Defenses" that are merely amplifications of Applicant's denials of a likelihood of confusion.

⁵ Certain testimony in the Heilbron Declaration was designated as Confidential Attorney's Eyes Only under the Board's Standard Protective Order and has been redacted. We will cite

Exhibits 45-214 thereto, 30 TTABVUE 2-555; and Opposer’s Second Notice of Reliance and Exhibits 215-20 thereto. 32 TTABVUE 2-75.⁶

Opposer also requests in its main brief that the Board “take judicial notice of the definition of ‘Kona’ as a ‘coastal region of Hawaii in the western part of the island of Hawaii.” 34 TTABVUE 22 n.6 (citing MERRIAM-WEBSTER DICTIONARY (merriam-webster.com)). Applicant accepts and relies on the referenced definition in its brief, 36 TTABVUE 7, and we grant Opposer’s request that we take judicial notice of this definition, and we have considered it for whatever probative value it may have.⁷

Applicant did not submit any evidence during its trial period. In its brief, Applicant requests that the Board take judicial notice of (1) the meaning of “triathlon,” *id.* at 8-9 (citing MERRIAM-WEBSTER DICTIONARY (merriam-webster.com)), and (2) “the well[-]known fact that Kona, Hawaii is the site of an annual Ironman triathlon,” referring “the Board to the Ironman® website,” to which Applicant provides a hyperlink. *Id.* at 9. With respect to the latter request, Applicant argues that the “fact that Kona, Hawaii is the site of an annual Ironman triathlon, and in particular the Ironman World Championship triathlon,” *id.*, is a fact “capable of accurate and ready determination by resort to sources whose accuracy cannot

the Heilbron Declaration by paragraph and exhibit number (e.g., “Heilbron Decl. ¶ 18; Ex. 33”) as well as by TTABVUE page numbers.

⁶ Opposer’s Second Notice of Reliance contains certain of Applicant’s discovery responses in which responses that were designated by Applicant as Confidential under the Board’s Standard Protective Order have been redacted.

⁷ “The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed form.” *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at *36 n.72 (TTAB 2021) (citations omitted).

reasonably be questioned,” *id.* n.2 (quoting Fed. R. Evid. 201), and that “the Ironman® website is a source whose accuracy cannot reasonably be questioned with respect to this fact.” *Id.* at 10.

In its reply brief, Opposer does not object to the request that we take judicial notice of the definition of “triathlon” from the MERRIAM-WEBSTER DICTIONARY, and we grant the request and have considered the definition for whatever probative value it may have.

Opposer does object to the request that we take judicial notice that Kona is the site of the Ironman Triathlon, on the grounds that “internet evidence is only relevant for what it shows on its face rather than for the truth of the matter asserted,” that “the Board has consistently declined to use web addresses to access site content,” and that “any proffered Internet material that does not show the date on which it was accessed and its source” is inadmissible. 38 TTABVUE 13-14 n.1.⁸

We sustain Opposer’s objection to the request that we take judicial notice that Kona is the site of the Ironman Triathlon because “Web addresses or hyperlinks are not sufficient to make the underlying webpages of record,” *In re ADCO Indus. – Techs., L.P.*, 2020 USPQ2d 53786, at *2 (TTAB 2020), and because we find that the private Internet website of the Ironman Triathlon is not a “source[] whose accuracy cannot reasonably be questioned” within the meaning of Rule 201 (b)(2) of the Federal

⁸ Opposer argues that “Applicant’s request that the Board take judicial notice of [a] *Wikipedia* entry referencing the fact that one of the many Ironman triathlon competitions take [sic] place in the Kona region of Hawaii is also insufficient to show that Kona is known generally to the American purchasing public.” 38 TTABVUE 12 (emphasis supplied by Opposer). Applicant does not request that the Board take judicial notice of any *Wikipedia* entry.

Rules of Evidence. *Cf. McGowen Precision Barrels, LLC v. Proof Rsch., Inc.*, 2021 USPQ2d 559, at *23 n.88 (TTAB 2021) (taking judicial notice of facts from a standard reference work).

II. Entitlement to a Statutory Cause of Action⁹

Although Applicant does not contest Opposer's entitlement to invoke the statutory cause of action for opposition, such entitlement "is an element of the plaintiff's case in every inter partes proceeding." *Chutter*, 2021 USPQ2d 1001, at *10 (citing *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277 (Fed. Cir. 2020), *cert. denied*, ___ U.S. ___ (2021); *Australian Therapeutic Supplies Pty Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir. 2020), *reh'g en banc denied*, 981 F.3d 1083, 2020 USPQ2d 11438 (Fed. Cir. 2020), *petition for cert. filed*, No. 20-1552 (Apr. 28, 2021); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014)). To establish its entitlement to a statutory cause of action, Opposer "must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) a reasonable belief in damage proximately caused by the registration of [Applicant's] mark." *Id.* (citing *Spanishtown Enters.*, 2020 USPQ2d 11388, at *1).

Opposer has established its entitlement to a statutory cause of action by properly introducing into evidence its pleaded registration of KONA for bicycles through

⁹ "We now refer to what previously had been called standing as 'entitlement to a statutory cause of action.' But our prior decisions and those of the Federal Circuit interpreting 'standing' under §§ 1063 and 1064 remain applicable." *Chutter*, 2021 USPQ2d 1001, at *10 n.39 (citing *Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020)).

attachment of PTO electronic records showing the current status and title of the registration to its First Amended Notice of Opposition. First Amended Not. of Opp. ¶¶ 3-5; Ex. A (23 TTABVUE 8, 13). *Chutter*, 2021 USPQ2d 1001, at *11.

III. Analysis of Section 2(d) Claim

Section 2(d) of the Trademark Act prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d).

A. Priority

In an opposition under Section 2(d), priority “may arise from a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights.” *DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *3 (TTAB 2020) (citing *Herbko Int’l Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002)). Applicant does not dispute Opposer’s priority.

As noted above, Opposer made of record its valid and subsisting pleaded Registration No. 1642717 of the standard character mark KONA for “bicycles,” and Applicant did not counterclaim to cancel it, so “priority is not at issue for the mark[] and the goods . . . identified in” the registration. *New Era Cap Co. v. Pro Era, LLC*,

2020 USPQ2d 10596, at *9 (TTAB 2020) (citing *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974)).

Opposer also pleaded use of its KONA mark in connection with “bicycle parts, tools, shirts, jerseys, shorts, socks, and hats” “[s]ince well prior to the May 24, 2018 filing date of Applicant’s intent-to-use application” First Amended Not. of Opp. ¶ 6 (23 TTABVUE 8).¹⁰ At trial, Mr. Heilbron provided uncontroverted testimony that Opposer and its predecessor-in-interest in the KONA mark, TBG The Bicycle Group, Inc. (“TBG”), which Mr. Heilbron also founded and served as Chairman, Heilbron Decl. ¶ 7 (29 TTABVUE 3), have used various stylized versions of the KONA mark in the United States in connection with apparel, including sports jerseys and shorts for cycling, since at least as early as 1990. Heilbron Decl. ¶¶ 8, 12; Exs. 5A-12 (29 TTABVUE 3-5, 44-76). Mr. Heilbron authenticated and testified about multiple archived webpages from Opposer’s website at konaworld.com and catalogs showing the historical use of stylized versions of the KONA mark on apparel during the period between 1990 and 2017. Heilbron Decl. ¶¶ 12-13; Exs. 5A-12 (29 TTABVUE 3, 43-76). We find that Opposer proved its priority of use of various stylized versions of the KONA mark in connection with apparel.

¹⁰ Applicant’s filing date is the earliest date on which it may rely for priority purposes. Applicant admitted in discovery that it made no sales of clothing bearing its mark prior to its filing date, Applicant’s Responses to Opposer’s Requests for Admission Nos. 4-5 (32 TTABVUE 64-65), and that its first sale of clothing bearing its mark was on February 27, 2019. Applicant’s Response to Opposer’s Interrogatory No. 1 (32 TTABVUE 16).

B. Likelihood of Confusion

Our determination of the likelihood of confusion under Section 2(d) of the Trademark Act is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). “[O]pposer has the burden of proving a likelihood of confusion by a preponderance of the evidence.” *Stratus Networks, Inc., UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at *3 (Fed. Cir. 2020).

“In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services.” *Chutter*, 2021 USPQ2d 1001, at *29 (citing *In re Chatham Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”)). Both parties discuss these key factors and the fifth *DuPont* factor, and Opposer also discusses the third, fourth, and eighth factors.

1. The Strength of Opposer’s Mark

We first consider the fifth *DuPont* factor, the “fame of the prior mark (sales, advertising, length of use, etc.),” *DuPont*, 177 USPQ at 567, because the strength of

Opposer's KONA mark potentially affects the scope of protection to which it is entitled.

“While dilution fame is an either/or proposition—fame either does or does not exist—likelihood of confusion fame ‘varies along a spectrum from very strong to very weak.’” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 957 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). “In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark itself, and its commercial strength, based on the marketplace recognition of the mark.” *Chutter*, 2021 USPQ2d 1001, at *30; *New Era*, 2020 USPQ2d 10596, at *10. “The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.” *Chutter*, 2021 USPQ2d 1001, at *30 (quoting 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:83 (5th ed. June 2018 update)).

a. Conceptual Strength

We must presume that Opposer's KONA mark for bicycles “is inherently distinctive--at least suggestive--because it is registered on the Principal Register.” *Sock It to Me, Inc. v. Fan*, 2020 USPQ2d 10611, at *10 (TTAB 2020). *See also New Era*, 2020 USPQ2d 10596, at *10 (“Opposer’s mark is inherently distinctive as evidenced by its registration on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act.”) (citing *Tea Bd. of India v.*

Republic of Tea, Inc., 80 USPQ2d 1881, 1899 (TTAB 2006)). Opposer's common law KONA mark for apparel does not enjoy the same presumption of inherent distinctiveness.

The parties agree that "Kona" refers to "a coastal region of Hawaii in the western part of the island of Hawaii." 34 TTABVUE 22 n.6; 36 TTABVUE 7. Applicant argues that KONA has "a clear geographical significance for bicycles," and is "clearly not an arbitrary mark." 36 TTABVUE 7. Applicant makes a convoluted argument that because Kona, Hawaii hosts a major triathlon competition each year, "Kona, Hawaii does indeed have a clear significance to bicycles, just as it might for other triathlon gear," and that "'Kona' is well descriptive of, and recognized as, a destination for athletes who will use certain of the goods in question." *Id.* at 10. Applicant quotes *Tea Bd. of India* for the proposition that "[g]eographically descriptive terms are generally regarded as inherently weak and entitled to less protection than arbitrary or suggestive marks." *Id.* (quoting *Tea Bd. of India*, 80 USPQ2d at 1899). Applicant "submits that this clear geographical significance and association, already used by a competitor in describing a quality (indeed, an alleged superiority) of their goods, must be considered, and must be understood to render [Opposer's] mark weak." *Id.*

Opposer argues in its main brief that the "commercial impression engendered by the mark KONA in connection with bicycles is arbitrary as there is no testimony or evidence that Kona has any geographical significance for bicycles," 34 TTABVUE 22-23, and that "[l]ikewise, KONA is an inherently strong mark for apparel, including jerseys/shirts and shorts" because "[a]s with bicycles, there is no testimony or

evidence that Kona has any geographical significance for apparel.” *Id.* at 23. In its reply brief, Opposer argues that the fact that “the term ‘Kona’ is a geographic term does not mean that it is geographically *descriptive* (or *misdescriptive*) of Opposer’s goods and does not rebut” the presumption that Opposer’s registered KONA mark for bicycles is inherently distinctive. 38 TTABVUE 10 (emphasis supplied by Opposer). Opposer contends that KONA is not conceptually weak for either bicycles or apparel because “the evidence of record fails to establish that [the] primary significance of the term ‘Kona’ is [a] geographic place known generally to the American purchasing public of bicycles or cycling apparel,” *id.* at 11, and that “even if Kona were a place generally known to the American consuming public, Applicant concedes that ‘no evidence has been shown that ‘Kona’ is recognized as a geographical source of the goods in question.” *Id.* at 11-12 (quoting 36 TTABVUE 10).

Opposer concludes that “the term KONA is not geographically descriptive of Opposer’s goods and is not ‘weak,’” and that “[a]t worst, even if there were evidence in the record establishing Kona’s reputation among the relevant public as a known source for coffee (which there is not), this would render KONA as applied to Opposer’s bicycles and apparel somewhat suggestive of the high-energy, caffeinated qualities of coffee, and perhaps the adventure associated with a tropical destination.” *Id.* at 12.

Applicant’s claim that Opposer’s KONA mark is weak for bicycles and apparel is problematic for several reasons. First, Applicant’s “argument directed toward the asserted [geographic] descriptiveness of . . . Opposer’s mark is in essence an attack on the validity of Opposer’s registration,” and the “Board cannot entertain such an

attack absent a counterclaim or petition to cancel the registration.” *Pierce-Arrow Soc’y v. Spintek Filtration, Inc.*, 2019 USPQ2d 471774, at *10 (TTAB 2019), *appeal dismissed per stipulation*, (Fed. Cir. Nov. 19, 2019). “Moreover, a claim of [geographic] descriptiveness is not available against Opposer’s registration, which is more than five years old.” *Id.* (citing 15 U.S.C. § 1064).

Second, the fact that Kona is a geographic place does not ipso facto make KONA weak as a trademark for either bicycles or apparel. *See, e.g., In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889, 893 (CCPA 1982) (“Geographic terms are merely a specific kind of potential trademark, subject to characterization as having a particular kind of descriptiveness or misdescriptiveness.”); *see also In re Newbridge Cutlery Co.*, 776 F.3d 854, 113 USPQ2d 1445, 1448-49 (Fed. Cir. 2015) (discussing three-prong test for geographic descriptiveness).¹¹ As discussed above, we have denied Applicant’s request to take judicial notice that Kona, Hawaii is the site of the Ironman Triathlon, but even assuming that Kona, Hawaii is known for that event, which involves the use of both bicycles and sports apparel,¹² the KONA mark is still

¹¹ Applicant’s reliance on *Tea Bd. of India* in support of its argument that KONA is conceptually weak is misplaced. 36 TTABVUE 10. Applicant accurately quotes the Board’s statement that “[g]eographically descriptive marks are generally regarded as inherently weak and entitled to less protection than arbitrary or suggestive marks,” *id.*, but omits the Board’s discussion regarding the impact of registration and the Board’s statement that “[o]rdinarily, a term that describes the geographic source of a product is not protectable without a showing of acquired distinctiveness.” *Tea Bd. of India*, 80 USPQ2d 1899. The case does not aid Applicant because KONA does not describe the geographic source of Opposer’s bicycles and apparel, and is thus not “geographically descriptive.”

¹² Mr. Heilbron defined a “triathlon” as “an endurance multisport race consisting of swimming, cycling, and running over various distances,” Heilbron Decl. ¶ 17 (29 TTABVUE 8), and Applicant’s application includes goods identified as “Triathlon clothing, namely, triathlon tights, triathlon shorts, triathlon singlets, triathlon suits.”

at worst suggestive for both sets of goods. *Cf. In re FCA US LLC*, 126 USPQ2d 1214, 1224 (TTAB 2018) (where Moab “is the name of a geographic location in Utah, known for its backcountry trails which are a popular destination for 4-wheel drive enthusiasts,” the MOAB mark for vehicles capable of off-road driving was “suggestive of the purpose of the goods and services, rendering the term somewhat weak conceptually.”).

Third, the record is devoid of evidence of third-party registrations of KONA that might suggest conceptual weakness because KONA “is commonly registered for similar goods or services.” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017).

We agree with Applicant that “KONA is clearly not an arbitrary mark,” 36 TTABVue 7, but it is suggestive for both bicycles and apparel and is, at worst, only mildly weak conceptually. *FCA USA*, 126 USPQ2d at 1224.

b. Commercial Strength

“Market strength is the extent to which the relevant public recognizes a mark as denoting a single source.” *Chutter*, 2021 USPQ2d 1001, at *30. “In other words, it is similar to acquired distinctiveness.” *Id.* “The proper standard is the mark’s ‘renown within a specific product market,’ and ‘is determined from the viewpoint of consumers of the product,’ and not from the viewpoint of the general public.” *Id.*, at *31 (quoting *Joseph Phelps Vineyards*, 122 USPQ2d at 1734-35).

The Board has explained that

[c]ommercial strength may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods or services sold under the mark, and

supported by other indicia such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods or services identified by the mark; and the general reputation of the goods or services.

New Era, 2020 USPQ2d 10596, at *10-11.

Opposer introduced evidence that its predecessor-in-interest TBG first used the KONA mark in connection with bicycles in 1988 and that Opposer has used the mark for bicycles continuously since 1994 following its assignment to Opposer, Heilbron Decl. ¶¶ 7-8 (29 TTABVUE 3), and that Opposer has used the KONA mark in connection with apparel, including sports jerseys and shorts for cycling, directly or through TBG, continuously since at least 1990. Heilbron Decl. ¶ 8 (29 TTABVUE 3). Mr. Heilbron testified that since 1989, more than 535,000 bicycles bearing the KONA mark have been sold in the United States, Heilbron Decl. ¶ 20 (29 TTABVUE 9), and that between 2016 and 2020, Opposer realized annual gross revenues in the low eight figures for bicycles and in the very low six figures for apparel. Heilbron Decl. ¶ 21 (28 TTABVUE 9).¹³

Mr. Heilbron testified that Opposer advertises its goods sold under the KONA mark online through its website at konaworld.com, via social media, through Internet videos, through print advertising, at trade shows, and in catalogs. Heilbron Decl.

¹³ The underlying round-number figures were designated by Opposer as Confidential Attorney's Eyes Only under the Board's Standard Protective Order. Notwithstanding that designation, we have discussed the level of Opposer's revenues in general terms because the "Board needs to be able to discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board's decisions." *Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1416 n.21 (TTAB 2016). The general level of Opposer's revenues is germane to the fifth *DuPont* factor, and there is no "overriding need" for total confidentiality of those figures.

¶¶ 12-14, 22; Exs. 5A-20 (29 TTABVUE 4-6, 10, 43-84). He testified that between 2016 and 2020, Opposer had annual advertising expenditures between the mid-six figures and the very low seven figures.¹⁴ Heilbron Decl. ¶ 25 (28 TTABVUE 10-11). He did not provide any breakdown between advertising in support of bicycle sales and advertising in support of apparel sales.

Opposer's bicycles and apparel sold under the KONA mark have also been exposed to potential purchasers through Opposer's sponsorship of competitive cycling teams and cyclists. Heilbron Decl. ¶ 15; Exs. 21-22 (29 TTABVUE 6, 85-97). Mr. Heilbron also testified that Opposer "has received extensive media coverage, industry recognition, and its bicycles have been featured on numerous well-known publications and review websites, including *Bike Magazine*, *Bike Racing Journal*, *Cyclocross Magazine*, and *Dirt Rag: Mountain Bike Magazine*," Heilbron Decl. ¶ 26 (29 TTABVUE 11), but he did not provide examples of such articles or describe the nature of the media coverage.

Applicant attacks this evidence on the ground that it "stand[s] outside of any meaningful context, such as any showing of overall sales of bicycles in the US, or any showing of actual impact of Opposer's advertising on market share or sales of their products." 36 TTABVUE 11. Applicant argues that Opposer "does not put its sales and advertising figures into any context or perspective by comparing them to the sales and advertising figures for similar products," "has not even addressed the size

¹⁴ The underlying round-number figures were also designated by Opposer as Confidential Attorney's Eyes Only under the Board's Standard Protective Order. We have treated them in the same manner as Opposer's revenue figures for the reasons discussed above.

of the relevant market, either in units of sale or dollar figures, let alone shown their [sic] own market share or prominence,” *id.*, and has not “demonstrate[d] any success of Opposer’s advertising campaigns, such as demonstrated cause-and-effect between any advertising campaign and following increase in sales.” *Id.* at 12. Applicant concludes that “Opposer has failed to establish commercial strength on the basis of their [sic] sales, advertising and sponsorships.” *Id.*

In its reply brief, Opposer states that it “has not argued, and is not arguing, that its mark is of such strength that it should be according [sic] special deference in the likelihood of confusion analysis.” 38 TTABVUE 15. Opposer acknowledges that “the evidence presented here may not provide the type of ‘market context’ to support a finding that Opposer’s mark is famous,” but submits that “it is nonetheless more than sufficient to find that Opposer’s KONA mark has some renown and is entitled to more than ‘the normal scope of protection to which inherently distinctive marks are entitled.’” *Id.* (quoting *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017)).

“Market share is but one way of contextualizing ad expenditures or sales figures,” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1690 (Fed. Cir. 2018) (citing *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002)), but because Opposer’s sales and advertising figures are nowhere close to the figures in cases in which marks have been found to be famous under Section 2(d),¹⁵ “some context in which to place

¹⁵ See *Bose*, 63 USPQ2d at 1306 (fame of ACOUSTIC WAVE mark supported by annual advertising expenditures of more than \$5 million over the 17 years of use of the mark prior

[Opposer's] raw statistics is reasonable," *Bose*, 63 USPQ2d at 1309, even taking into account that Opposer claims only that its KONA mark has "some renown." 38 TTABVUE 15.

Opposer did not provide such context, particularly with respect to apparel. *Cf. Omaha Steaks*, 128 USPQ2d at 1690 (finding that the opposer had "provided considerable contextual evidence of the type of advertisements and promotions it uses to gain sales," including "national radio and television campaigns, free-standing print campaigns, and mention in national magazines, including *Time*, *Newsweek*, *Playboy*, and *PC Magazine*, and newspapers, including *USA Today*, the *Wall Street Journal*, the *New York Times*, and the *LA Times*," television promotions on "Fox & Friends,' 'Hell's Kitchen,' 'Celebrity Apprentice,' and 'The View,'" "features of Omaha Steaks products on 'The Oprah Winfrey Show,' 'The Ellen DeGeneres Show,' 'Food Factory,' 'Unwrapped,' and 'Military Makeover,'" and "unsolicited movie and TV allusions to Omaha Steaks"); *Joseph Phelps Vineyards*, 122 USPQ2d at 1734-35 (finding that the

to 2002); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000) (fame of the opposer's FRITO-LAY mark shown by expenditures in 1996 of about \$80 million and other evidence, including the facts that "[i]n any given year, over 90 percent of American households purchase at least one FRITO-LAY brand product" and that "FRITO-LAY products enjoyed a greater than 50 percent market share in the estimated \$12.1 billion domestic snack chip industry."); *Omaha Steaks*, 128 USPQ2d at 1690 (fame of OMAHA STEAKS mark supported by advertising expenditures of \$45 million in 2011 and over \$50 million in 2012 and 2013); *Kimberly-Clark Corp. v. H. Douglas Enters., Ltd.*, 774 F.2d 1144, 227 USPQ 541, 542 (Fed. Cir. 1985) (fame of HUGGIES mark supported by \$15 million in advertising in the year 1982 alone); *Auto Zone Parts, Inc. v. Dent Zone Cos.*, 100 USPQ2d 1356, 1361-62 (TTAB 2011) (fame of AUTOZONE mark supported by advertising expenditures of over \$750 million during 23-year period of use, with the Board finding that although the petitioner had "not placed its sales and advertising figures in context," such context was "not necessary here in view of the volume of sales and advertising expenditures and the fact that petitioner's advertising reaches over 90% of the U.S. population numerous times each year.").

opposer had provided evidence that its “INSIGNIA wine is renowned in the wine market and among consumers of fine wine” in the form of numerous articles lauding the wine and its producer, and evidence that INSIGNIA wine had been served at the White House).

“Considering the record as a whole, including evidence pertaining to both inherent and commercial strength,” and taking into account that KONA is registered for bicycles and is thus presumed to be at least suggestive, the KONA mark for bicycles “is appropriately placed in the middle of the ‘spectrum from very strong to very weak.’” *Chutter*, 2021 USPQ2d 1001, at *34 (quoting *Joseph Phelps Vineyards*, 122 USPQ2d at 1734). Opposer’s common law KONA mark for apparel has modest conceptual strength at best, and has not been shown to have any appreciable commercial strength. It is appropriately placed slightly off center on the “weak” portion of the spectrum. We accord Opposer’s KONA mark for both sets of goods the “normal scope of protection to which inherently distinctive marks are entitled,” *Bell’s Brewery*, 125 USPQ2d at 1347, and the fifth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

2. Similarity or Dissimilarity of the Marks

The first *DuPont* factor focuses “on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Chutter*, 2021 USPQ2d 1001, at *34-35. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Id.*, at *35 (quoting *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019)).

The proper test regarding similarity “is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks and citation omitted)). “The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks.” *Chutter*, 2021 USPQ2d 1001, at *35. Because Applicant admits that “its Class 25 goods are general consumer goods,” Applicant’s Response to Opposer’s Interrogatory No. 2 (32 TTABVUE 17), and because the remaining goods in the application include various broadly identified goods such as “Shirts,” “without any restrictions or limitations as to their nature, price, or other features, the average customer here is an ordinary consumer.” *In re Embiid*, 2021 USPQ2d 577, at *11 (TTAB 2021).

Marks must be considered in their entirety, but “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)).

Applicant argues that the dominant portion of its **KONA81** mark is the number “81” rather than the word “Kona.” Applicant claims that “the word ‘Kona’ by itself, as a ‘weak’ element, should be afforded little weight” in the comparison of the marks, that the comparison should be “made in view of other aspects or elements of the mark, 36 TTABVUE 13, and that “[m]inimally weighing the word ‘Kona’ itself in comparison of the marks, other aspects will dominate.” *Id.* at 14-15. Opposer responds in its reply brief that “KONA is the dominant element of Applicant’s mark,” 38 TTABVUE 16-17, and that there “is no ‘rational reason’ to accede to Applicant’s demand that the Board give ‘little weight’ in comparison’, 36 TTABVUE 15, to the entirety of Opposer’s mark and the first and only word element of Applicant’s mark.” *Id.* at 17.

We agree with Opposer. The word “Kona” is the first element in Applicant’s mark and as such it is “likely to make the greatest impression on consumers.” *Detroit Athletic Co.*, 128 USPQ2d at 1049 (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992)). *See also Palm Bay Imps.*, 73 USPQ2d at 1692; *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988).

Given the structure of Applicant’s mark, we also agree with Opposer that the number “81” appended to the stylized word “Kona” “could be perceived as merely indicating a different line of Opposer’s goods or as a shorthand description of the year the brand was first launched.” 34 TTABVUE 26. We find that the word KONA is the dominant portion of Applicant’s mark, and turn now to the required comparison of

the marks in their entireties, giving greater weight in that comparison to the word KONA than to the number 81 in Applicant's mark.

The comparison of the marks in their entireties is obviously straightforward. "Applicant, of course, concedes that the word 'Kona is common to both Applicant's mark **KONA81** and Opposer's mark KONA," 36 TTABVUE 12, because Applicant's mark contains Opposer's entire mark. "While there is no explicit rule that marks are automatically similar" under these circumstances, "likelihood of confusion has often been found where the entirety of one mark is incorporated within another." *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *6-7 (TTAB 2019) (quoting *Hunter Indus., Inc. v. Toro Corp.*, 110 USPQ2d 1651, 1660 (TTAB 2014)). Applicant offers no persuasive reason why the marks here should not be found to be confusingly similar under these circumstances.

With respect to appearance, Applicant argues that "[a]s a threshold matter, visually comparing the marks side-by-side, they look different. Simply stated, **KONA81** looks different from Opposers [sic] KONA. Even considering the common use of the word Kona, the marks clearly differ in appearance." 36 TTABVUE 14. Applicant further argues that

Considering **KONA81** in comparison to KONA, distinguishing features of **KONA81** include the stylized fonts and addition of the number 81 to the word Kona. Side by side, it is easy to distinguish the marks from one another in light of these features alone. Notably, Applicant's **KONA81** is depicted in two fonts - a letter font perhaps evocative of an east Asian or pacific island character, and the differently appearing 81. The evocative letter font of the word Kona, together with the strikingly different font for the number 81, give

Applicant's mark ~~KONA~~^{KONA81} a striking appearance clearly distinct from Opposer's KONA.

Id. at 15.

These arguments apply the wrong test for similarity in appearance. “[M]arks ‘must be considered . . . in light of the fallibility of memory’ and ‘not on the basis of side-by-side comparison.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977)). Applying the correct test, “whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties,” *Cai*, 127 USPQ2d at 1801, and taking into account “the recollection of the average customer, who retains a general rather than specific impression of the marks,” *Chutter*, 2021 USPQ2d 1001, at *35, the marks are quite similar in appearance.

Opposer's registered mark KONA for bicycles is in standard characters, and thus “could be used in any typeface, color, or size, including the same stylization actually used or intended to be used by [Applicant], or one that minimizes the differences or emphasizes the similarities between the marks.” *Anheuser-Busch, Inc. v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1823 (TTAB 2015) (citing *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011)). Accordingly, we must assume that Opposer's KONA mark for bicycles could be displayed in the manner of the word KONA in Applicant's mark, as shown below:

KONA

Applicant's common law KONA mark has been displayed in various stylized forms, but the most recent one, which appears to have been used for several years prior to the filing date of Applicant's application, is shown below:



Heilbron Decl. ¶ 12; Exs. 11-12 (29 TTABVUE 5, 73-75).

A consumer with a “general rather than specific impression” of these depictions of Opposer's KONA marks who is exposed separately to Applicant's **KONA81** mark would be very unlikely to notice the visual differences between the marks discussed in Applicant's side-by-side comparison. We find that Applicant's mark is very similar in appearance to Opposer's marks.

Applicant also argues that

considering the sound of the two marks in comparison, **KONA81** (pronounced kona-eighty-one) is phonetically dominated by “eighty-one” - weighting the phrase according to syllables, **KONA81** consists of five full syllables (ko-na-eight-y-one), wherein “eighty-one” constitutes three of the five. In comparison, Opposer's mark KONA only consists of two syllables (ko-na), leaving the “eighty-one” included in Applicant's mark a phonetically dominant element.

36 TTABVUE 15. Consumers do not focus on minutia such as the number of syllables in each mark, but rather form “general rather than specific impressions” of marks. *See In re John Scarne Games, Inc.*, 120 USPQ 315, 316 (TTAB 1959) (“Purchasers of game boards do not engage in trademark syllable counting[;] they are governed by

general impressions made by appearance or sound, or both.”). *See also Bridgestone Americas Tire Operations LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012) (“Exact identity is not necessary to generate confusion as to source of similarly-marked goods.”). We find that Opposer’s KONA marks and Applicant’s ~~KONA~~⁸¹ mark are quite similar in sound because the word KONA sounds the same when both marks are verbalized.

Applicant does not advance any specific arguments regarding the dissimilarity of the marks on connotation and commercial impression. As noted above, the parties agree that KONA refers to a coastal region of Hawaii in the western part of the island of Hawaii, and Applicant does not argue, much less show, that KONA brings to mind one thing when it is used as Opposer’s mark and something different when it is used as the first part of Applicant’s mark. *See Embiid*, 2021 USPQ2d 577, at *21. We find that the marks are quite similar in meaning when considered in their entireties.

“Applicant cannot avoid likelihood of confusion by adopting [Opposer’s] entire mark and adding subordinate matter thereto.” *Stawski v. Lawson*, 129 USPQ2d 1036, 1052 (TTAB 2018) (citing *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1003 (Fed. Cir. 2012); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1375 (TTAB 2006)). The marks are quite similar in all means of comparison, and the first *DuPont* factor strongly supports a finding of a likelihood of confusion.

3. Similarity or Dissimilarity of the Goods and Channels of Trade

The second and third *DuPont* factors respectively consider “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or

registration,”¹⁶ and “the similarity or dissimilarity of established, likely-to-continue trade channels.” *Detroit Athletic Co.*, 128 USPQ2d at 1051-52 (quoting *DuPont*, 177 USPQ at 567).

a. Similarity or Dissimilarity of the Goods

“[G]oods need not be identical to be found related; rather, they need only be related in such a manner that they could be encountered by the same consumer under situations that would lead to the mistaken belief that they originate from the same source.” *Chutter*, 2021 USPQ2d 1001, at *42 (citing *Coach Servs.*, 101 USPQ2d at 1713).

Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods are used together or used by the same purchasers; advertisements showing that the relevant goods are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant’s goods and the goods listed in the [involved] registration.

Embiid, 2021 USPQ2d 557, at *22 (citing *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *5 (TTAB 2020)).

Opposer argues that the “bicycles” identified in its registration of KONA, and the apparel on which it proved prior common law use of the stylized KONA mark, are either identical to or related to the identified goods remaining in Applicant’s

¹⁶ The list of goods remaining in the application following the entry of partial summary judgment against Applicant is extensive, but it is unnecessary for Opposer to prove likelihood of confusion with respect to each remaining good. “It is sufficient for a finding on likelihood of confusion that relatedness is established for any item encompassed by the identification of goods in the application.” *DeVivo*, 2020 USPQ2d 10153, at *11 (citing *Tuxedo Monopoly, Inc. v. Gen Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)).

application. 34 TTABVUE 17-20. On Opposer's argument regarding its registered mark, we must compare the goods identified in Applicant's application to the "bicycles" identified in the registration. On Opposer's second argument regarding its common law mark for apparel, we must compare the goods identified in the application and the goods for which Opposer has established common law rights. *DeVivo*, 2020 USPQ2d 10153, at *13.

We begin with Opposer's second argument that it "has continuously used the KONA mark with the same goods listed in [Applicant's] Application, resulting in common law trademark rights in the identical goods." 34 TTABVUE 17. Applicant responds that the goods are not identical and that Opposer's claim is overly broad, at best." 36 TTABVUE 15. Applicant points to Mr. Heilbron's testimony regarding prior use of the KONA mark on "sports jerseys and shorts *for cycling*," *id.* (citing Heilbron Decl. ¶ 8 (29 TTABVUE 3) (emphasis supplied by Applicant), and argues that its application "includes no reference to apparel, or anything else, *for cycling*." *Id.* (emphasis supplied by Applicant). Applicant notes that several goods were removed from the application when the Board granted Opposer's motion for partial summary judgment, *id.* at 17, including "Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms;" "Clothing for athletic use, namely, padded pants;" "Clothing for athletic use, namely, padded shirts;" "Clothing for athletic use, namely, padded shorts;" and "Cyclists' jerseys." 27 TTABVUE 1-2. Applicant concludes that "[n]othing among Applicant's applied for list of goods states,

or suggests bicycles or cycling apparel, and none of the listed goods give rise to any likelihood of confusion.” 36 TTABVUE 17.

The goods remaining in the application include goods identified as “Sport shirts,” “Sports jerseys and breeches for sports,” “Sports pants,” and “Shirts.” Where, as here, “the goods in the application at issue are broadly identified as to their nature and type,” we must presume that they encompass “all the goods of the nature and type described therein” *Jump Designs*, 80 USPQ2d at 1374. Accordingly, because cycling is a sport, we agree with Opposer that “Applicant’s broadly-worded identification of various ‘sport’ apparel items necessarily includes cycling,” 38 TTABVUE 8,¹⁷ and we must assume that “sports jerseys” encompass jerseys for cycling, that “sports pants” encompass pants for cycling, and that “sports shirts” and “shirts” encompass shirts for cycling. *Cf. New Era*, 2020 USPQ2d 10596, at *13 (the involved application included goods identified as “caps,” and “[b]ecause it is unrestricted, ‘caps’ encompasses all types of caps, including the ‘athletic caps’ identified” in the opposer’s registration). Opposer has established priority of use of the KONA mark for jerseys for cycling, pants for cycling, and shirts for cycling, Heilbron Decl. ¶¶ 8, 12; Exs. 5A-12 (29 TTABVUE 3-5, 44-76), and the goods

¹⁷ Applicant stated on its website that its Men’s Sports Tight Shorts are “perfect for all sport activities, including running, **biking**, yoga, gym fitness and etc.” 32 TTABVUE 50 (emphasis added). Despite that statement, Applicant claims in its brief that its “goods are directed to swimwear and not cycling apparel, notwithstanding how some customers may chose [sic] to wear their apparel,” 36 TTABVUE 17, but its intentions for the use of its goods are irrelevant because its application seeks registration of its mark for a host of broadly identified sports apparel. The goods “recited in the application determine the scope of the post-grant benefit of registration,” and “[p]arties that choose to recite [goods] in their trademark application that exceed their actual [goods] will be held to the broader scope of the application.” *Stone Lion*, 110 USPQ2d at 1163.

identified in the application as “Sport shirts,” “Sports jerseys and breeches for sports,” “Sports pants,” and “Shirts” are legally identical to the goods on which Opposer has shown prior common law use of the KONA mark.

Opposer also argues that it has “submitted evidence showing that Applicant’s goods are related to the goods identified in its ’717 Registration—bicycles in Class 12,” 34 TTABVUE 19, in the form of Mr. Heilbron’s testimony regarding Opposer’s sales of both sets of goods and sales of both sets of goods by others in Opposer’s industry, and third-party registrations of marks for “both bicycles in Class 12 and cycling and/or triathlon-related apparel in Class 25” *Id.* at 20. Applicant does not address Opposer’s evidence or arguments regarding the relatedness of bicycles and sports apparel.

Mr. Heilbron testified that Opposer sells both “bicycles and apparel branded with the KONA trademark . . . including sports jerseys and shirts, affixed with the KONA mark.” Heilbron Decl. ¶ 5; Exs. 1-2 (29 TTABVUE 3, 14-22). We display below one of Opposer’s bicycles, one of Opposer’s shirts, and one of Opposer’s pants:



Heilbron Decl. Ex. 1 (29 TTABVUE 14).



Heilbron Decl. Ex. 2 (29 TTABVUE 19).



Heilbron Decl. Ex. 2 (29 TTABVUE 20). Opposer and TBG have used the KONA mark in connection with both bicycles and apparel since 1990. Heilbron Decl. ¶ 8 (29 TTABVUE 3).

Mr. Heilbron further testified that “Kona is not the only brand in the U.S. market that offers both bikes and cycling-related apparel under the same brand,” and that at

least 10 other companies “offer both bikes and cycling apparel, including items such as sports jerseys and shorts, branded with the same marks.” Heilbron Decl. ¶ 16; Exs. 23-32 (29 TTABVUE 6-8, 97-231).

Opposer also made of record numerous use-based third-party registrations of marks for both “bicycles” and some form of “jerseys,” “shorts,” “sports pants,” or “shirts.” Opposer’s First Notice of Reliance Exs. 53, 57-72, 74-76, 79-85, 87-88, 93-99, 102-03, 105-10 (30 TTABVUE 37-40, 51-123, 129-39, 151-78, 183-89, 205-25, 231-36, 240-42, 243-57).

The third-party uses and registrations establish that bicycles and the goods identified in the application as “Sport shirts,” “Sports jerseys and breeches for sports,” “Sports pants,” and “Shirts” are related because they commonly emanate from the same source under the same mark. *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *6-10 (TTAB 2019).

The goods identified in the application as “Sport shirts,” “Sports jerseys and breeches for sports,” “Sports pants,” and “Shirts” are legally identical to the goods on which Opposer proved priority of common law use of KONA, and are related to the “bicycles” identified in Opposer’s registration of KONA. The second *DuPont* factor supports a finding of a likelihood of confusion.

b. Similarity or Dissimilarity of Channels of Trade

Opposer’s common law rights in its KONA mark for apparel “are limited to the actual goods and channels of trade for which it uses its mark,” *Hunter Indus.*, 110 USPQ2d at 1661, but “[t]here are no limitations as to channels of trade or classes of purchasers in the identification of goods in [A]pplicant’s application,” and it

“therefore is presumed that [A]pplicant’s goods move in all channels of trade normal for those goods, and that they are available to all classes of purchasers for those goods.” *Id. See also Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 116 USPQ2d 1102, 1117 (TTAB 2015).

Opposer sells its KONA apparel “direct-to-consumers online as well as at wholesale to third party retailers.” Heilbron Decl. ¶ 8 (29 TTABVUE 3). Applicant’s goods identified as “Sport shirts,” “Sports jerseys and breeches for sports,” “Sports pants,” and “Shirts” must be deemed to travel in all channels of trade for such goods, which Mr. Heilbron testified include “specialty and chain stores, department stores, ‘big-box’ mass retailers, and direct-to-consumer.” Heilbron Decl. ¶ 28 (29 TTABVUE 11). Applicant stated in discovery that its intended channels of trade for its goods include “distributors, independent dealers, [and] independent stores.” Applicant’s Response to Opposer’s Interrogatory No. 10 (32 TTABVUE 19). We find that the actual channels of trade for Opposer’s apparel bearing the KONA mark and the deemed channels of trade for the “Sport shirts,” “Sports jerseys and breeches for sports,” “Sports pants,” and “Shirts” identified in the application at least overlap because they both include retail stores. *See Bd. of Regents, Univ. of Tex. Sys. v. S. Ill. Miners, LLC*, 110 USPQ2d 1182, 1193 (TTAB 2014) (channels of trade for the parties’ clothing overlapped because they both included “national and local retail stores”).

Mr. Heilbron testified that the “standard channels of trade for bicycles” were the same as those for apparel, namely, “specialty and chain stores, department stores, ‘big-box’ mass retailers, and direct-to-consumer.” Heilbron Decl. ¶ 28 (29 TTABVUE

11). He further testified that “[i]n the U.S., many retail stores that feature bicycles also often feature or carry cycling apparel, such as sports jerseys and shorts,” particularly those that “focus on consumers who participate in, train for, or enjoy the challenge of triathlons,” Heilbron Decl. ¶ 17 (29 TTABVUE 8), and he authenticated pages from the websites of three such retailers. Heilbron Decl. ¶ 18; Exs. 33-35 (29 TTABVUE 8, 232-88). We find that the channels of trade for “bicycles” and the deemed channels of trade for the “Sport shirts,” “Sports jerseys and breeches for sports,” “Sports pants,” and “Shirts” identified in the application at least overlap because they both include retail stores.

The third *DuPont* factor supports a finding of a likelihood of confusion.

4. Purchase Conditions and Consumer Sophistication

The fourth *DuPont* factor considers “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *Sock It to Me*, 2020 USPQ2d 10611, at *7 (quoting *DuPont*, 177 USPQ at 567).

Opposer argues that “[a]pparel such as jerseys/ shirts and shorts are typically an ordinary consumer item and can be bought by the general public online or off the shelf via retail and mass merchandisers and department stores” and that “[c]ycling-related apparel can run in the \$10-\$25 range, as illustrated by listings from online retailers Walmart and Backcountry.” 34 TTABVUE 14 (citations omitted). Opposer further argues that “Applicant’s goods can be relatively inexpensive ordinary consumer items that are offered for sale for as little as \$10.” *Id.* at 21. Applicant does not address these arguments in its brief.

The goods identified in the application as “Sport shirts,” “Sports jerseys and breeches for sports,” “Sports pants,” and “Shirts” “include[] all goods of the type identified, without limitation as to their nature or price,” *Sock It to Me*, 2020 USPQ2d 10611, at *8, and they are presumed to include goods “that are relatively inexpensive.” *Id.* Applicant admitted in discovery that “its Class 25 goods are general consumer goods,” Applicant’s Response to Opposer’s Interrogatory No. 2 (32 TTABVUE 17), and that “the typical price of the goods ranges from USD 20 to USD 50.” Applicant’s Response to Opposer’s Interrogatory No. 19 (32 TTABVUE 35).

“When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.” *Sock It to Me*, 2020 USPQ2d 10611, at *8 (quoting *Recot*, 54 USPQ2d at 1899). “Because the buyers to whom sales are made are all general consumers, and the goods at issue are relatively low-priced and subject to impulse buying, we find that the fourth *DuPont* factor weighs in favor of finding a likelihood of confusion.” *Id.*

5. The Absence of Evidence of Actual Confusion

The eighth *DuPont* factor considers the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ at 567. Opposer volunteers that there has been no actual confusion, but argues that the two years of the parties’ concurrent use of their marks “is a relatively short period of time to provide a meaningful opportunity for confusion to occur, even where the parties both offer their goods via the Internet,” 34 TTABVUE 28, and that “there is no evidence that shows that Applicant’s limited use of its mark

with swimwear occurred in any significant volume or geographic scope such that it would give rise to an opportunity for actual confusion to occur.” *Id.* at 28-29. Opposer concludes that “the actual confusion factor is, at most, neutral.” *Id.* at 29. Applicant does not address this factor in its brief.

“The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by [A]pplicant of its [~~KONA~~81] mark for a significant period of time in the same markets as those served by [Opposer] under its mark [KONA].” *Chutter*, 2021 USPQ2d 1001, at *46 (citing *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff’d*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011)). “In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred.” *Id.* For the reasons discussed by Opposer, we find that there has not been such an opportunity, and the eighth *DuPont* factor is thus neutral in our analysis of the likelihood of confusion.

6. Conclusion

The key first and second *DuPont* factors support a finding of a likelihood of confusion because the marks are quite similar and the goods are legally identical in part and otherwise related. The third and fourth *DuPont* factors also support a finding of a likelihood of confusion because the channels of trade for the goods overlap and the goods include relatively inexpensive apparel that may be subject to purchase with a reduced degree of care. The fifth and eighth *DuPont* factors are neutral. We find, on the basis of the record as a whole, that Opposer proved by a preponderance

of the evidence that it has priority in the use of its KONA mark and that consumers of the goods identified in the application as “Sport shirts,” “Sports jerseys and breeches for sports,” “Sports pants,” and “Shirts” sold under the **KONA** mark are likely to believe mistakenly that such goods originate with, or are sponsored or authorized by, Opposer.

Decision: The opposition is sustained as to all of the goods remaining in the application, namely, “Bath sandals; Bath slippers; Bathing suits for men; Bathing caps; Bathing costumes; Bathing suits; Bathing trunks; Beach footwear; Beach shoes; Dry suits; Fitted swimming costumes with bra cups; Leather shoes; Parts of clothing, namely, gussets for tights, gussets for stockings, gussets for bathing suits, gussets for underwear, gussets for leotards and gussets for footlets; Protective neck and arm guards made of neoprene or other materials to prevent wetsuit chafing; Rash guards; Rash vests; Sandals and beach shoes; Skating outfits; Ski suits for competition; Ski wear; Skiing shoes; Skirt suits; Snow boarding suits; Sport coats; Sport shirts; Sports caps and hats; Sports jerseys and breeches for sports; Sports jackets; Sports pants; Sports vests; Surf wear; Swim wear; Swim wear for gentlemen and ladies; Swimming caps; Travel clothing contained in a package comprising reversible jackets, pants, skirts, tops and a belt or scarf; Triathlon clothing, namely, triathlon tights, triathlon shorts, triathlon singlets, triathlon suits; Vested suits; Waterproof footwear; Waterproof jackets and pants; Waterproof leather shoes and boots; Wet suit gloves; Wet suits for water-skiing and sub-aqua; Bottoms as clothing; Pullovers; Shirts; Swimsuits.”